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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,555	08/03/2001	Michael J. O'Neill	2507/101	9456
2101 7590 06/18/2007 BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			EXAMINER WOO, JULIAN W	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 06/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/922,555

Applicant(s)

O'NEILL, MICHAEL J.

Examiner

Julian W. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17, 33-38, and 45-61 is/are pending in the application.
- 4a) Of the above claim(s) 45-61 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 and 33 is/are allowed.
- 6) ☒ Claim(s) 34-38 is/are rejected.
- 7) ☒ Claim(s) 45-61 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Reissue Applications***

#### ***Claim Objections***

1. Claims 45-61 are objected to because of the following informality: Each of these claims includes the status identifier "(new)," which is not required under 37 CFR 1.173. Appropriate correction is required.

#### ***Election/Restrictions***

2. Newly submitted claims 45-61 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: They are directed to a method of harvesting bone with a coring device including a hollow cylindrical shaft and a cutting tip with two protruding blades joined at one end or an opening or a cutting tip with an opening and a protruding blade, where the method is performed with a distinct coring device and without a guided delivery system.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-61 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (1,493,240) in view of Barber (4,512,344). Bohn discloses the inventions substantially as claimed. Bohn discloses, at least in figures 1-8 and in page 1, lines 14-25 and page 2, lines 30-51 and 77-112; a method of harvesting bone, where the method includes inserting a hollow cylindrical coring device (16) comprising a permanently attached cutting tip (16), directing a downward force on the coring device to engage a downward-facing cutting edge extending in a circumferential direction with respect to a circle in a plane perpendicular to a longitudinal axis defined by a shaft (15) of the coring device, where the downward-facing cutting edge extends circumferentially around less than a full circle. However, Bohn does not disclose that the coring device is inserted through a guided delivery system and through a percutaneous incision, nor does Bohn disclose the mode in which the cutting tip is attached to the coring device. Barber teaches, at least in figure 16 and in col. 1, lines 7-32 and col. 4 lines 34-52; a bone-cutting tool inserted through a guided delivery system (e.g., 61) and through a percutaneous incision. It would have been obvious to one having ordinary skill in the art

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at the time the invention was made, in view of Barber, to modify the method of Bohn, so that the coring device is inserted through a guided delivery system and through a percutaneous incision. Such a modification would allow the coring device to harvest bone without injuring adjacent anatomical structures or tissues during movement of the device to and from a surgical site. Moreover, it would have been a matter of obvious design choice to apply a mode of assembly as claimed. The choice would be dependent upon the what manufacturing methods are available to the manufacturer, upon the materials applied in the cutting tip and coring device, and upon the desired strength of the bond between the cutting tip and the coring device.

***Allowable Subject Matter***

5. Claims 1-17 and 33 are allowed.

***Response to Amendment***

6. Applicant's arguments with respect to claims 45-61 have been considered but are moot in view of the abovementioned election/restriction. The indication of allowable subject matter in claims 34-38 is hereby withdrawn in view of the new grounds of rejection. The oath/declaration of February 8, 2007 has been accepted and entered.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weilandt (5,655,542) teaches a coring device.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian W. Woo  
Primary Examiner

June 12, 2007